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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/734,411 | 12/12/2003 | Matthew F. Brown | PC25082A | 1172 |

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PFIZER INC.
PATENT DEPARTMENT, MS8260-1611
EASTERN POINT ROAD
GROTON, CT 06340

| EXAMINER | |
|---|---|
| OWENS, AMELIA A | |
| **ART UNIT** | **PAPER NUMBER** |
| 1625 | |

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/734,411 | MATTHEW F. BROWN ET AL | |
| | Examiner | Art Unit | |
| | Amelia A. Owens | 1625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-15 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.



PD

**DETAILED ACTION**

Claims 1-15 are pending. No drawings were filed with the application. Foreign priority was not claimed.

***Information Disclosure Statement***

The examiner has considered the IDS.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

**The nature of the invention:** The nature of the invention is the therapeutic method of inhibiting MIP-1alpha and/or RANTES from binding to the receptor CCR1; treating a condition mediated by inhibiting MIP-1alpha and/or RANTES from binding to the receptor CCR1; therapeutic

method of treating a condition mediated by inhibiting the production of metalloproteinases and cytokines at inflammatory sites. See claims 11-15.

**The state of the prior art and predictability:** See USP 6,677,343 B2 which teach piperazine compounds. The reference has a date of January 13, 2004 and is therefore not applicable as prior art. Further note that compounds differ structurally from the claimed compounds. See abstract. Moreover, the state of the prior art is that it involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities (i.e. what compounds can treat which specific disease). There is no absolute predictability even in view of the seemingly high level of skill in the art. It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In re Fisher, 427 F. 2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. In the instant case, the instantly claimed invention is highly unpredictable since one skilled in the art would recognize that in regards to the therapeutic effects of diseases, conditions, or disorders whether *inhibiting MIP-1alpha and/or RANTES from binding to the receptor CCR1; treating a condition mediated by inhibiting MIP-1alpha and/or RANTES from binding to the receptor CCR1; treating a condition mediated by inhibiting the production of metalloproteinases and cytokines at inflammatory sites* would make a difference in the particular disease, disorder or condition. Therefore, applicants' statement at page 6 line 27 through page 8 line 9 is seen to be prophetic at best. The language merely describes applicants' intent for the compound. It is not clear that the claimed diseases, conditions, or disorders are 'treated' via the claimed pathways.

Applicant is invited to come in with a declaration utilizing the claimed compounds showing positive treatment of a disease, disorder or condition by *inhibition of MIP-1alpha and/or RANTES from binding to the receptor CCR1; treating a condition mediated by inhibiting MIP-1alpha and/or RANTES from binding to the receptor CCR1; therapeutic method of treating a condition mediated by inhibiting the production of metalloproteinases and cytokines at inflammatory sites*. Further, the myriad of diseases, conditions or disorders claimed are unrelated and ordinarily not known to be treatable by the same compounds. Generally a particular compound or class of compounds is known to treat a particular disease or type of diseases. It is not known in the art that a particular compound or class of compounds is effective in treating such diverse diseases, conditions or disorders. The applicant is invited to point out such a teaching to the examiner.

**Guidance and working examples:** Compounds according to the invention have been prepared. The assay at page 29 is noted. However, no correlation between the assay and any disease, disorder or condition is noted, nor is a correlation between the particular pathway and any disease, disorder or condition noted. Applicants have not demonstrated that a single compound according to the invention can treat any disease, condition or disorder by inhibiting MIP-1alpha and/or RANTES from binding to the receptor CCR1; treating a condition mediated by inhibiting MIP-1alpha and/or RANTES from binding to the receptor CCR1; therapeutic method of treating a condition mediated by inhibiting the production of metalloproteinases and cytokines at inflammatory sites. Applicants' are attempting to claim every known disease, condition or disorder as well as future diseases, conditions and disorders and such is wholly inoperable.

The compounds have been included in the rejection as no viable utility for the compounds is noted. Applicants have yet to establish the compounds effective in treating any disease, condition or disorder.

Thus, the specification fails to provide sufficient support of the broad use of the compounds of claim 1 for the treatment of any disease. As a result necessitating one of ordinary skill to perform an exhaustive search, for which diseases can be treated by which compound of claim 1 in order to practice the claimed invention.

Therefore, in view of the Wands factors and In re Fisher (CCPA 1970) discussed above, to practice the claimed invention herein, one of ordinary skill in the art would have to engage in undue experimentation to test which diseases can be treated, prevented, ameliorated by the compounds of the instant claims, with no assurance of success.

This rejection can be overcome by deleting the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

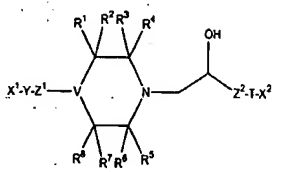
Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what the scope of the claims embraced by the language *inhibition of MIP-1alpha and/or RANTES from binding to the receptor CCR1; treating a condition mediated by inhibiting MIP-1alpha and/or RANTES from binding to the receptor CCR1; therapeutic method of treating a condition mediated by inhibiting the production of metalloproteinases and cytokines at inflammatory sites*. Further it is unclear what the scope of such terms as autoimmune

diseases; acute and chronic inflammatory conditions; gastrointestinal inflammation is. In addition, the intended coverage of scope encompassed those character and conditions that will be correlated to future discovery to be related to the diseases or conditions or disorders so named and as such is wholly inoperable. The scope of the claims is made even more confusing given the recitation of the myriad of diseases in the claims. The rejection is not limited to the relatively few terms actually mentioned above but by the totality of the claims.

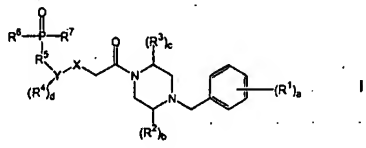
***Double Patenting***

Copending applications 10/198,237; 10/346684; 10/759562; 10/759555 directed compounds of the following formula are noted. Z1/Y is –alkyl(monocyclic heteroarylene); V = carbon or nitrogen.



Formula I

However, they differ from the instantly claimed compounds that have the following formula.



I

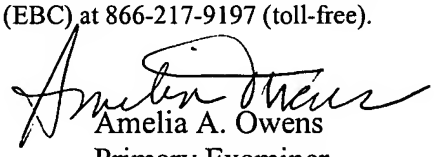
The claimed compounds have a P(O)R6(R7)R5-; and a CH2phenyl group bonded directly to ring nitrogen not present in the copending applications. Novelty resides in the presence of these groups. Note further that the copending applications have a CH2-CH(OH) group bonded directly

to ring nitrogen which is not present in the claimed compounds. Therefore no double patenting rejection will be made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday from 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Amelia A. Owens
Primary Examiner
Art Unit 1625